



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,307	12/10/2004	Hiroto Kikuchi	259431US0PCT	3909
22850 7590 07/11/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER KOSAR, AARON J	
			ART UNIT	PAPER NUMBER
			1609	
			NOTIFICATION DATE	DELIVERY MODE
			07/11/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/516,307	Applicant(s) KIKUCHI ET AL.	
	Examiner Aaron J. Kosar	Art Unit 1609 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,13-26,29-33 and 35-42 is/are pending in the application.
- 4a) Of the above claim(s) 1,4-6,13-26,29 and 35-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/10/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election with traverse of group VI, claims 30-33, in the reply filed on March 20, 2007, is acknowledged. The traversal is on the ground(s) that distinction between the groups has not been sufficiently asserted and burden has not been shown to exist in searching the eight claim groups. This is not found persuasive because the groups were shown to not have a special technical feature as the common technical feature, difructose dianhydride III (DFA III), was shown to have been described in the prior art, thus unity of invention is lacking and the groupings of the methods of purifying (grouped according to the myriad of reagents, process steps, and products produced), the product composition of DFA III, and a culture of *Arthrobacter sp.*

In accordance with the rules set forth in PCT Rule 3.1 and 37 CFR 1.475:

a) An international or national stage application shall relate to one invention or to a group of inventions so linked as to form a single general inventive concept. Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same corresponding special technical features. The expression "special technical feature" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or

Art Unit: 1651

- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

The groups of the invention fall within category (1), however, PCT Rule 13.2 does not provide for multiple compositions (*e.g.* pure *Arthrobacter sp.* culture and DFA III) or multiple methods of making/using within a single application. Thus the first appearing composition is combined with a corresponding first method of making/using and the additional composition and method claims each constitute separate groups.

Thus a group of inventions must belong to one of the specific categories provided by PCT Rule 13.2, such as a composition and a method of use of the composition, *and* in addition must have a special technical feature that unites them. See Patent Rule 1.475, where a special technical feature is a contribution *over the prior art*.

The requirement is still deemed proper and is therefore made FINAL.

Claim 29 had been inadvertently omitted from the groupings and is grouped with group V. Claims 1,4-6,13-26,29, and 35-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or

Art Unit: 1651

linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on March 20, 2007.

Drawings

The drawings are objected to because figure 3 contains the term “firm”, which appears to be inconsistent with or a translation error of the word “route”. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.³³

Specification

The disclosure is objected to because of the following informalities: The term “firm” which appears to be inconsistent with or a translation error of the word “route” (e.g. page 31, etc.).

Art Unit: 1651

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 30-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "%" in claim 30 is a relative term, which renders the claim indefinite. The term "%" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The units defining the numerator and denominator of percentage are undefined, rendering the claims indefinite.

The dependent claims are rejected as depending upon a rejected base claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by TOMITA (PTO-892, N, 3/20/2007(Derwent – English abstract of JP 03-259090) or TANAKA (PTO-1449, AP, 12/10/2004: JP 49-117688 (English Abstract)).

The claims are drawn generally to a method of purifying a difructose dianhydride III (DFA III) containing solution, having a purity of DFA III <70%.

Tomita teaches a method for purifying DFA III (Derwent- English abstract). Tomita teaches purification using centrifugation to defecate the suspended particles, and filtering by passage through activated carbon and silicates (Derwent- English abstract, lines 7-9). Tomita also teaches a purity of DFA III of less than 70% in that Tomita teaches a composition comprising 95% components other than inulin. Thus even 100% conversion of inulin to DFA III by the inulinase would produce a composition comprising no more than 5% DFA III. Tomita also teaches action of a fructosyltransferase upon a fructose/fructose-containing polymer by teaching the reaction of inulinase upon inulin to produce DFA III (Derwent- English abstract, line 1).

Claim 32 has been included in the rejections of Tomita because it does not *per se* require one to select treating with yeast as the method of purifying, and thus does not preclude the “defecating and filtrating” or “chromatographing” steps.

Tanaka teaches the DFA product in solution (500 ml extract); less than 70% pure (0.5g DFA recoverable per 500 ml extract); the use of yeast, including fermenting; defecation (filtering boiled/sliced burdock); adsorption onto active carbon; filtering to separate the solid carbon adsorbate from the liquid filtrate; chromatographing (eluted with 5% ethanol) in the purification of the difructose dianhydride product (Tanaka, English abstract).

Art Unit: 1651

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Kosar whose telephone number is (571) 270-3054. The examiner can normally be reached on Monday-Thursday, 7:30AM-5:00PM, ALT. Friday, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ajk/

Aaron Kosar
Examiner, Art Unit 1651

SANDRA E. SAUCIER
PRIMARY EXAMINER

